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In re Application of Dewen Qiu et al.
Serial No.: 09/597,840
Filed: June 20, 2000
Attorney Docket No.: 19603/3340 (CRF D-2018B)

: PETITION DECISION

This is in response to applicants' petition, filed September 27, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(b) on June 20, 2000 as a divisional of application 09/013,587, filed January 26, 1998, which claimed benefit of provisional application 60/036,048, filed January 27, 1997. The application, as filed, contained claims 38-51. On September 7, 2001, the examiner mailed a restriction requirement dividing the claims into 7 groups. In the response filed January 10, 2002, applicants elected Group II, claims 38, 39, 41 and 46-50, with claims 38, 39 and 46-50 to be examined as drawn to methods utilizing a nucleic acid encoding a hypersensitive response elicitor protein from *Erwinia amylovora*. Applicants traversed the restriction requirement on essentially the same grounds presented in the instant petition, discussed below. Applicants also argued that the restriction was improper because claims 38, 39 and 46-50 were not designated as linking claims.

On March 27, 2002 the examiner mailed a first action on the merits. The examiner made the restriction final, clarifying that the claims 38, 39 and 46-50 were regarded as linking claims.

DISCUSSION

Applicants present two lines of argument in the petition. First, applicants argue that hypersensitive response elicitors are recognized in the art as a class of related compounds, and therefore restriction based on the source of the elicitor is inappropriate. This argument is not persuasive because different nucleic acid sequences are considered by the Office to be independent and distinct inventions. As stated in MPEP 803.04:

> Nucleotide sequences encoding different proteins are structurally distinct chemical

> compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

By analogy, methods utilizing different nucleic acid sequences are also independent and distinct inventions.

Applicants further argue that the hypersensitive response elicitors share common characteristics, but stop short of stating that prior art regarding one sequence would render the others obvious. Given the unpredictability of the art, as discussed by the examiner in the Office action on the merits, it would appear that the skilled artisan would not predict that the results obtained with one elicitor protein would be obtained with all the others. Therefore a proper examination of all the claimed inventions would require a search for nucleic acids encoding all six of the specifically claimed elicitor proteins. Moreover, the claims require nucleic acids encoding elicitor proteins which "correspond to" those produced by the specified pathogens. Thus each invention encompasses an ill-defined genus of proteins and nucleic acid sequences, not a single sequence.

Applicants' second line of argument is that the methods should all be classified in the same class and subclass, and therefore restriction is not proper. This argument is not persuasive. MPEP 808.02 states, in part:

> Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:
>
> (C) A different field of search : Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together.

Applicants are advised that a search of the available sequence databases produces a listing of references disclosing the sequences most similar to the query sequence. This is the "place" where the examiner searches for prior art. The prior art relating to another query sequence will not be found in this "place" - a different listing of references must be generated and searched by the examiner. Thus a different field of search is shown, and restriction is proper.

DECISION

Applicants's petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the amendment and response filed September 27, 2002.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll
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